REMARKS

By this Amendment, Applicant amends claim 8 to improve clarity. Claims 8-17 are pending in this application.

In the Office Action,[1] the Examiner rejected claim 8 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejected claims 8-11 and 13 under 35 U.S.C. § 102(b) as being anticipated by Iijima (U.S. Patent No. 5,365,045); rejected claims 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Iijima in view of *Applied Cryptography* by Schneier; and rejected claims 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Iijima in view of Grimonprez et al. (U.S. Patent No. 5,473,690).

Applicant respectfully traverses the rejection of claim 8 under 35 U.S.C. § 112, second paragraph. In the rejection, the Examiner notes that the claim recites "the validity data," and alleges "it is not clear if the validity data referred is the validity data included in the command message or the stored validity data indicating whether the security function is valid in a nonvolatile memory." *See* Office Action, page 3. Applicant has amended claim 8 to further clarify the claimed "validity data" by providing antecedent basis for the second occurrence of the term. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 8 under 35 U.S.C. § 112, second paragraph.

Applicant respectfully traverses the Examiner's rejection of claims 8-11 and 13 under 35 U.S.C. § 102(b) as anticipated by Iijima. To properly anticipate Applicant's claimed invention under 35 U.S.C. § 102(b), the Examiner must demonstrate the

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *See* M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Claim 8 recites a portable electronic device with a security function including, among other things, "first means for writing or rewriting data in the nonvolatile memory . . . when the first determining means determines that the command message does not include the validity data and the second determining means determines the validity data is not stored in the nonvolatile memory." The Examiner has not shown that Iijima teaches at least this feature of claim 8.

The Examiner alleges in the Response to Arguments section of the Office Action that "the function of the validity data as an indicator of the validity of a security function includes, inter alia, a check for DF assignment ..., verifying data in a user area ..., and a verification step when the issuer of an IC card checks a memory of the card." *See* Office Action, page 3. The Examiner thus appears to argue that Applicant's claimed "validity data" reads on Iijima's assignment flag 34 due to the citation made by the Examiner in the Office Action. Applicant respectfully disagrees.

Iijima discloses that assignment flag 34 is turned "off" in an initial state, and is turned "on" when one DF (data file) is defined. *See* col. 5, lines 57-59. FF flag 35 is turned "on" in an initial state, and indicates that all the data in user area 20B is of a

value "FF." *See* col. 5, lines 59-60. If it is determined that input command data is optional data write command data, control element 15 checks if assignment flag 34 is "on." *See* col. 10, lines 42-45. If it is determined that assignment flag 34 is "on," then control element 15 outputs response data indicating that a command is not executable. *See* col. 10, lines 45-48. However, if it is determined that assignment flag 34 is "off," control element 15 turns on the FF flag on the RAM and initializes a writing pointer. *See* col. 10, lines 52-53.

However, the above operations of Iijima are performed to detect an abnormality of a memory during a write operation. *See* Abstract; col. 1, lines 26-29 and 45-58; col. 10, lines 16-20 and 57-65. Accordingly, Iijma discloses checking whether a memory cell has malfunctioned, but not whether validity data for a security function allows or prohibits writing or rewriting of data. Although Iijima discloses detecting a memory abnormality, the reference fails to teach or suggest "first means for writing or rewriting data in the nonvolatile memory . . . when the first determining means determines that the command message does not include *the validity data* and the second determining means determines *the validity data* is not stored in the nonvolatile memory," as recited in claim 8 (emphasis added).

Applicant also notes that, with regard to the Examiner's allegations on page 3 of the Office Action, the "optional data" taught by Iijima also does not constitute the claimed "validity data indicating *whether the security function is valid*," as recited in claim 8 (emphasis added). For example, Iijima discloses that "externally input optional data is stored in a user open area (second storage area), and is compared with another externally input optional data to check memory cells of the user open area. In this

manner, malfunctions of address and data bus signals supplied to a memory unit can be easily found." *See* col. 2, lines 43-49. While Iijma discloses using "optional data" to check whether a memory cell has malfunctioned, the optional data in Iijma also does not constitute Applicant's claimed "validity data *indicating whether the security function is valid*," as recited in claim 8. Claim 8 is therefore not anticipated by Iijima for at least the above reasons. Accordingly, the Examiner should withdraw the rejection of claim 8 under 35 U.S.C. § 102(b).

Dependent claims 9-11 and 13 depend from claim 8. For at least the same reasons discussed above, dependent claims 9-11 and 13 are also allowable over Iijima. Accordingly, Applicant requests the Examiner to withdraw the rejection of claims 9-11 and 13.

Applicant respectfully traverses the rejection of claims 12 and 14 under 35 U.S.C. § 103(a) as unpatentable over Iijima in view of Schneier. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. *See* M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. *See* M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. *See* M.P.E.P. § 2143 (8th ed. 2001).

Claims 12 and 14 depend indirectly from allowable claim 8. The Examiner applies Schneier because the reference allegedly discloses "several general protocols to verify data using digital signatures and hashes." *See* Office Action, 7. Even if the Examiner's allegation were correct, Schneier does not disclose or suggest at least "first means for writing or rewriting data in the nonvolatile memory . . . when the first determining means determines that the command message does not include the validity data and the second determining means determines the validity data is not stored in the nonvolatile memory," as recited in claim 8. Accordingly, Schneier does not make up for the above described deficiencies of Iijima. Claims 12 and 14 are therefore allowable over the applied references at least due to their dependence from claim 8.

Applicant respectfully traverses the rejection of claims 15-17 under 35 U.S.C. § 103(a) as unpatentable over Iijima in view Grimonprez.

Claims 15-17 depend indirectly from allowable claim 8. In the Office Action, the Examiner alleges Grimonprez "discloses a secure method for loading a plurality of applications no to a microprocessor of an IC card wherein each application has a corresponding security program." *See* Office Action, page 7. Even if the Examiner's allegation were correct, Grimonprez does not teach or suggest at least "first means for writing or rewriting data in the nonvolatile memory . . . when the first determining means determines that the command message does not include the validity data and the second determining means determines the validity data is not stored in the nonvolatile memory," as recited in claim 8. Accordingly, Grimonprez does not overcome the deficiencies of Iijima discussed above. Claims 15-17 are therefore allowable over the applied references at least due to their dependence from claim 8.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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